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09/832,211	04/10/2001	Marjorie B. Medina	0164.98	1182

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
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13

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 13

Application Number: 09/832,211
Filing Date: April 10, 2001
Appellant(s): MEDINA, MARJORIE B.

G. Byron Stover
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/23/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 13-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

a) The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

b) Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13, and 16-24 are indefinite because it includes the trademark "TWEEN". The trademark cannot be used because the composition covered by this trademark is solely within the control of the trademark owner and maybe subject to change over time at the sole discretion of the owner. The use of the trademark TWEEN has been noted in this application. It must be capitalized wherever it appears and be accompanied by the generic terminology, refer to MPEP 608.01 (v) and MPEP 2173.05 (u).

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

(11) Response to Argument

a) Appellant argues that the Trademark "TWEEN" is not indefinite because the term "TWEEN" has appeared in 248 patents since 1976. Appellant's arguments are unpersuasive for the following reasons.

The term TWEEN is a well-recognized Trademark for a group of surface-active agents, as described in Hackh's Chemical Dictionary (1969). Appellant also recognizes that the term "TWEEN" is a well recognized trademark (page 3, Section VIII Arguments). However, appellant as failed to properly treat the trademark. The MPEP, section 608.01(v) specifically

addresses the use of Trademarks in the specification and claims. Specifically, it states that the Trademark should be capitalized wherever it appears and be accompanied by the generic terminology. TWEEN is a trademark which describes a group of surface-active agents. Further, the examiner maintains that there is no generic terminology for the term TWEEN by itself. The trademark "TWEEN" accompanied by a number, example "TWEEN 80" does in fact have meaning and a generic terminology. The instant specification, as described on page 3 also does not provide a generic definition for the term TWEEN and Appellant has failed to also provide the examiner with a generic definition for the term "TWEEN". While Appellant acknowledges that the term TWEEN is a trademark, Appellant has failed to address the examiner's arguments directed to the improper use of Trademarks, as specifically discussed in MPEP 608.01 (v). Therefore, the term "TWEEN" by itself, as described in the claims, renders each claim indefinite. It should be noted that page 3 of the specification teaches TWEEN 80. A generic terminology exists for the term "TWEEN 80", however, the claims recite only the term "TWEEN" and not "TWEEN 80".

Appellant's arguments directed to the citation of 248 patents are unpersuasive since each application is treated on its own merits.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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bsc
September 30, 2003

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